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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,853	09/22/2003	Jie-Wei Chen	03-562	1394

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EXAMINER

HARAN, JOHN T

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,853

Applicant(s)

CHEN ET AL.

Examiner

John T. Haran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the means" in line 10. There is insufficient antecedent basis for this limitation in the claim. It appears the limitation should state - - the focusing means - -.

It is noted that in claim 4 it appears "engaging" is the incorrect verb tense.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 2 rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al (US 2004/0154737)

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The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Chen et al disclose a laser welding apparatus comprising a processing head (15) with focusing devices (2,8) for directing a laser beam onto a contact surface that passes through a rotatably mounted laser beam transparent roller (18) that exerts pressure on the work through pressing devices (4) (See Figures). Chen et al anticipate claim 1.

Regarding claim 2, the processing head has passages capable of having air injected therethrough (See Figures).

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Itagaki (JP 58163587).

Itagaki discloses a laser welding apparatus comprising a processing head (7) with focusing means (8) that focus a laser beam and directs it through a laser transparent roller (17) that exerts pressure on the weld through spring pressing devices (19) (See Figures and English abstract). Itagaki anticipates claim 1.

Regarding claim 2, the processing head has passages capable of having air injected therethrough (See Figures).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being obvious over Chen et al (US 2004/0154737) as applied above to claims 1 and 2.

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Regarding claims 3-4, it is well known and conventional in the laser welding art to have a plurality of parallel weld lines and to have a separate processing head for each weld line and to have a spacer between adjacent processing head. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include such in the apparatus of Chen et al.

Regarding claim 5, one skilled in the art would have readily appreciated that pistons are a conventional pressing device and are alternate expedients to springs (which are taught by Chen et al as the pressing device) and it would have been obvious to utilize a conventional pressing device in the apparatus of Itagaki, such as a piston.

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itagaki (JP 58163587) as applied above to claims 1 and 2.

Regarding claims 3-4, it is well known and conventional in the laser welding art to have a plurality of parallel weld lines and to have a separate processing head for each weld line and to have a spacer between adjacent processing head. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include such in the apparatus of Itagaki.

Regarding claim 5, one skilled in the art would have readily appreciated that pistons are a conventional pressing device and are alternate expedients to springs and it would have been obvious to utilize a conventional pressing device in the apparatus of Itagaki, such as a piston.

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9. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Azdasht (DE 4319742) in view of Itagaki (JP 58163587).

Azdasht is directed to a laser welding apparatus comprising a processing head (1) that allows a laser beam to be directed within it and through a laser transparent roller (3) that exerts pressure on the weld area (See Figure and English abstract).

Azdasht is silent towards having a focusing means for focusing the laser beam or a pressing device that presses the processing head against the weld area. One skilled in the art would have readily appreciated that it is conventional in the laser art to have focusing means for focusing the laser, as shown for example in Itagaki (see Figure 4). One skilled in the art also would have readily appreciated that the processing head (bond head) of Azdasht would need a pressing device of some sort in order to exert pressure on the weld, especially in light of Itagaki which teaches such (Figure 6b).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a focusing means and pressing device in the apparatus of Azdasht as suggested in Itagaki.

Regarding claim 2, the processing head has passages capable of having air injected therethrough (See Figure).

Regarding claims 3-4, it is well known and conventional in the laser welding art to have a plurality of parallel weld lines and to have a separate processing head for each weld line and to have a spacer between adjacent processing head. It would have been obvious to do so in the apparatus of Azdasht.

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Regarding claim 5, one skilled in the art would have readily appreciated that pistons are a conventional pressing device and it would have been obvious to utilize a conventional pressing device in the apparatus of Azdasht.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/667,708 (US 2004/0154737). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the copending application teaches all the limitations of claim 1 of the present application.

Regarding claim 2, the processing head has passages capable of having air injected therethrough (See Figures).

Regarding claims 3-4, it is well known and conventional in the laser welding art to have a plurality of parallel weld lines and to have a separate processing head for each

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weld line and to have a spacer between adjacent processing head. It would have been obvious to do so in the apparatus of the copending application.

Regarding claim 5, one skilled in the art would have readily appreciated that pistons are a conventional pressing device and it would have been obvious to utilize a conventional pressing device in the apparatus of copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-5 are directed to an invention not patentably distinct from claim 9 of commonly assigned copending application 10/667,708 (US 2004/0154737).

Specifically, as noted above claim 9 of the copending application teaches all the limitations of claim 1 of the present application.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned copending application 10/667,708 (US 2004/0154737), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

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A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

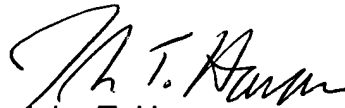
Chen et al (US 2003/0213552) is cited as teaching having a laser beam transparent roller in a welding apparatus but it is not connected to a processing head.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John T. Haran whose telephone number is (571) 272-1217. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John T. Haran
Primary Examiner
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